



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,940	11/21/2003	David Carroll Challener	RPS920030161US1	2917
55128	7590	06/30/2006	EXAMINER	
VANLEEUVEN & VANLEEUVEN			CHANNAVAJJALA, SRIRAMA T	
P.O. BOX 90609			ART UNIT	
AUSTIN, TX 78709-0609			PAPER NUMBER	

2166

DATE MAILED: 06/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/718,940	Applicant(s) CHALLENGER ET AL.	
	Examiner Srirama Channavajjala	Art Unit 2166	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/21/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-20 are presented for examination.

Drawings

2. The Drawings filed on 11/21/2003 are acceptable for examination purpose

Information Disclosure Statement

3. The information disclosure statement filed on 11/21/2003 is in compliance with the provisions of 37 CFR 1.97, and has been considered and a copy is enclosed with this Office Action.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. ***Claims 1-20 are rejected under 35 U.S.C. 101 because invention is directed to non-statutory subject matter.***

As set forth in MPEP 2106(II)A:

Identify and understand Any Practical Application Asserted for the Invention The claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." State Street, 149 F.3d at 1373, 47USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an

idea or concept, or is simply a starting point for future investigation or research (Brenner v. Manson, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96); In re Ziegler, 992, F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)). Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention, i.e., why the applicant believes the claimed invention is useful.

Apart from the utility requirement of 35 U.S.C. 101, usefulness under the patent eligibility standard requires significant functionality to be present to satisfy the useful result aspect of the practical application requirement. See Arrhythmia, 958 F.2d at 1057, 22 USPQ2d at 1036. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting. For example, a claim directed to a word processing file stored on a disk may satisfy the utility requirement of 35 U.S.C. 101 since the information stored may have some “real world” value. However, the mere fact that the claim may satisfy the utility requirement of 35 U.S.C. 101 does not mean that a useful result is achieved under the practical application requirement. The claimed invention as a whole must produce a “useful, concrete and tangible” result to have a practical application.

5. Regarding claim 1, 8,14, “a computer implemented method of managing a client profile, said method comprising: sending a client request to a computing device, the client request including a request for master profile information; receiving the master profile information from the computing device, wherein the master profile information corresponds to a master profile and includes a master profile location; and retrieving the master profile using the master profile location” is directed to “abstract idea” because all of the elements in the claim 1 would reasonably be interpreted by one of ordinary

Art Unit: 2166

skill in light of the disclosure as software, such that managing a client profile steps is software, per se, is “non-statutory subject matter” and ***claim 1*** do not have “***practical application***” because the “final result” by the claimed invention in the claim 1 elements particularly “receiving the master profile information from the computing device, wherein the master profile information corresponds to a master profile and includes a master profile location and retrieving the master profile using the master profile location” merely retrieving the master profile but not producing “***useful, tangible and concrete result***”, therefore, claim 1 is a non-statutory subject matter. The claimed invention is subject to the test of State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02. Specifically State Street sets forth that the claimed invention must produce a “***useful, concrete and tangible result.***” The Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility states in section IV C. 2 b. (2) (on page 21 in the PDF format):

The tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing. However, the tangible requirement does require that the claim must recite more than a § 101 judicial exception, in that the process claim must set forth a practical application of that § 101 judicial exception to produce a real-world result. Benson, 409 U.S. at 71-72, 175 USPQ at 676-77 (invention ineligible because had “no substantial practical application.”).

Art Unit: 2166

Claim 1,8,14 have the result of producing ***“real-world”*** results related to receiving the master profile information from the computing device, wherein the master profile information corresponds to a master profile and includes a master profile location; and retrieving the master profile using the master profile location”, however the claim[s] do not specify that the result (retrieving the master profile using the master profile location) neither displayed nor outputted to a user or otherwise used in the real world, furthermore, no *use of “receiving the master profile information from the computing device, wherein the master profile information corresponds to a master profile and includes a master profile location; and retrieving the master profile using the master profile location”* is set forth that would constitute a real-world result. Thus the claimed result is not tangible and thus the claimed result is not a ***“useful, concrete and tangible result.”*** The court in State Street noted that the claimed invention in Alappat constituted a practical application of an abstract idea because it produced *a useful, concrete and tangible result* the display of a smoothed heart beat to a system user. The Federal Circuit further ruled that it is of little relevance whether a claim is directed to a machine or process for the purpose of a § 101 analysis. AT&T, 172 F.3d at 1358, 50 USPQ2d at 1451 (see the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, Annex II).

The examiner reviewed the specification [page 7-10, page 14-17] but was unable to find a practical real-world use of the result. If the applicant is able to find one

Art Unit: 2166

and inserts it into the claims provide the location the element[s] is found in the specification.

In view of above analysis of claims 2-7,9-13,15-20 depend from claim 1,8,14 respectively is also rejected.

See for further information: <<http://www.uspto.gov/web/offices/pac/dapp/ogsheet.html>>

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. ***Claims 1-20, are rejected under 35 U.S.C. 102(b) as being anticipated by Raymond, US Pub. No. 2002/0158899, published on Oct 31,2002.***

8. As to claim 1,8,14, Raymond teaches a system which including “a computer implemented method of managing a client profile, said method comprising:

‘sending a client request to a computing device, the client request including a request for master profile information’ [page 2, col 1, 0015, page 6, col 1, 0069],

Raymond is directed to managing resources in a networked computing environment, more specifically customers computing devices are connected to the network [local,

wide area network or wireless or internet] for example as detailed in fig 1; further user

interface is capable of receiving information from the service information as detailed in

fig 1; also Raymond specifically teaches "customer database" is maintained within computing environment that corresponds to master profile information;

'receiving the master profile information from the computing device, wherein the master profile information corresponds to a master profile and includes a master profile location' [page 6, col 1, 0071, col 2, 0077-0078], Raymond specifically teaches service information portal in which module library and data miner connected to the framework and data miner modules also connected to the customer database, instruction databases and other system utility tools database as detailed in fig 2, further module library registry is a database of registration files identifies the path as detailed in page 6, col 2, 0078;

'retrieving the master profile using the master profile location' [page 7, col 1, 0079, 0083], Raymond specifically teaches module manager stores the retrieved data mines from the registration file, typically provides the file attributes that including various attributes as detailed in page 7, col 1, 0083. .

9. As to claim 2, 9,15, "Raymond disclosed' matching the master profile information with an existing profile' [page 9, col 2, 0109, line 1-7].

'determining whether to perform the retrieving based upon the matching' [page 9, col 2, 0109, line 19-25];

'performing the retrieving in response to the determination.' [page 9, col 2, 0110]

10. As to claim 3,10,16, Raymond disclosed 'retrieving a revision time corresponding to the existing profile' [page 11, col 1, 0121].

'comparing the revision time with a master profile revision time that corresponds to the master profile'[page 11, col 1, 0122]

11. As to claim 4, 11,17, Raymond disclosed 'determining whether to automatically retrieve the master profile' [page 11, col 2, 0126].

'retrieving the master profile in response to the determination'[page 7, col 1, 0079, 0083] ;

'detecting whether to notify a user of the master file retrieval' [page 9, col 1, 0105].

'notifying the user in response to the detecting' [page 9, col 1, 0106].

12. As to claim 5,12,18, Raymond disclosed, 'the method of claim 4 further comprising: 'querying the user in response to the determination as to whether to retrieve the master profile' [page 10, 0119];

'receiving a response from the user in response to the query' [page 11, 0124];

'identifying whether to retrieve the master profile based upon the response' [page 11, col 2, 0126];

'performing the retrieving in response to the identifying' [page 11, col 2, 0128].

Art Unit: 2166

13. As to claim 6, 13,19, Raymond disclosed 'computing device is adapted to identify the master profile information using client properties included in the client request' [page 12, col 2, 0137]; 'wherein the client properties are selected from the group consisting of a client location and a user functionality description' [page 12, col 2, 0138].

14. As to claim 7, 20, Raymond disclosed 'the computing device is adapted to use authorization information included in the client request in order to determine whether to send the master profile information' [page 12, col 2, 0139]

Conclusion

The prior art made of record


a. US Pub.No. . 2002/0158899

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Srirama Channavajjala whose telephone number is 571-272-4108. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:30 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alam, Hosain, T, can be reached on (571) 272-3978. The fax phone numbers for the organization where the application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free)

SC

Patent Examiner.
June 12, 2006.


SRIRAMA CHANNAVAJJALA
PRIMARY EXAMINER